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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,365	06/22/2001	Jeffrey M. Cogen	08964/00001	7029

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EXAMINER

KRAMER, JAMES A

ART UNIT                      PAPER NUMBER

3627

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/887,365

Applicant(s)

COGEN, JEFFREY M. *cb*

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 10/18/04.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-66 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-66 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    - 1.  Certified copies of the priority documents have been received.
    - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-8, 12-14, 16-17, 19, 22, 27-30, 32, 35, 38-40, 42-43, 45, 48, 52, 54-56, 58, 59, and 61-63 are rejected under 35 U.S.C. 102(a) as being anticipated by Handheld HQ/Supersync/Pocket Rx/Pocket Parts TV Sync by Kliot and Glass (hereinafter Handheld HQ).

Handheld HQ teaches an external infrared transmitter and receiver connected to a computer terminal. A signal is transmitted to or received from the handheld device in order to upload information to or download information from the two devices (i.e. the handheld device and the computer terminal).

Handheld HQ further teaches potential applications for the system. Examiner specifically references Application 16: Restaurant menus can be uploaded either at the restaurant or online to a handheld device. An order can then be entered into the handheld device and uploaded by the consumer at the restaurant (e.g. at the register or at the drive-thru window). Examiner notes that this clearly teaches displaying a menu listing a plurality of items available from a restaurant, receiving selection from the user, storing selection in an order file in a memory storage device on transportable computer and remotely transmitting order file to a receiving terminal at a location of item provider without physical connection between transportable computer and receiving terminal (Independent claims 1, 13, 28 and 39 and dependent claim 43, 52, 55 and 64).

Examiner further notes that the potential application of Handheld HQ includes multiple restaurants (indicated by the terminology "restaurant menus"). As such the reference anticipates selecting a restaurant from among a list (independent claim 54, dependent claims 3 and 4).

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Claims 2, 14 and 40, further require that the order file be transferred between the transportable computer and the receiving terminal without telephony or satellite communication. Examiner notes that that the infrared teaching of Handheld HQ clearly indicates that the order file is transmitted from the PDA (transportable computer) to the restaurant (receiving terminal) without either telephony or satellite communications.

Claim 5 requires that the menu comprises a listing of all items available for ordering from item provider. Examiner notes it is inherent to the teaching of Handheld HQ, that an entire listing of items available are upload, when the user uploads the menu for a restaurant.

Claim 7 requires that the order file is transmitted via infrared transmission. Examiner once again notes that this is the basic teaching of Handheld HQ.

Claims 8, 17, 30, 56 and 59 require that the order file be formatted for reception by an IrDA compliant infrared receiver. Examiner notes that since the order file of HandHeld HQ is sent via an infrared transmission the order file MUST be formatted for reception by an IrDA compliant infrared receiver as there is no other way to transfer the file, as such this limitation is inherent to the teachings of Handheld HQ.

Claims 12, 27 and 38 require that item provider be a restaurant. Examiner once again points to Potential Application 16 of Handheld HQ indicating specific use in a restaurant.

Claims 16, 29, 42 and 61 requires that the transmission receiver be positioned adjacent to a customer drive-through lane. Handheld HQ clearly states that the consumer uploads the order at the drive-thru window (Potential Application number 16).

Claims 19, 32, 45 and 62 require the remote transmission receiver be positioned at a customer service counter. Handheld HQ states that the consumer uploads the order at the

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register. Examiner notes that a register is a customer service counter and therefore Handheld HQ anticipates this limitation.

Claims 22, 35, 48 and 63 require the receiving terminal be positioned at a personal customer dining location at said item provider location. Handheld HQ clearly states as an example that the consumer uploads the order at the drive-thru window or at the register.

Examiner asserts that Handheld HQ, therefore anticipates the terminal position at a personal customer dining location.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 18, 31, 44, 57 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handheld HQ in view of How Infrared Laser Data Transmission Compares with Radio Frequency Transmission (hereinafter Compares).

Handheld HQ, as discussed in detail above, fails to teach remotely transmitting order file via radio frequency transmission. Compares teaches that there are two main wireless transmission methods, infrared laser (taught by Handheld HQ) and radio frequency. Compares further teaches that infrared laser is unsuitable for installation in heavy fog-prone areas. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Handheld HQ by replacing the infrared transmission with radio frequency in order to provide a more robust transmission signal suitable for

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installation in heavy fog-prone areas. This would be especially important for installation at a drive-through window.

Claims 6, 11, 15, 25 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handheld HQ in view of U.S. Patent Number 5,969,968 to Pentel (hereinafter 968).

Claim 6 requires the editing of the previously stored items in the order file. Handheld HQ, as described in detail above fails to teach editing the previously stored items in the order file. 968 teaches a remote ordering system which includes a "remove" key on a remote device. Upon pressing the "remove" key a list of items ordered with item number, description and quantity appears on the screen. The user is then able to use the remote device to select which item to remove (column 4; lines 36-45). Examiner interprets the function of removing an item from the order to be equivalent to editing the order.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the PDA of Handheld HQ to include a "remove" key, which would enable the user to remove (edit) the order file prior to transmitting it to the receiving terminal. One of ordinary skill in the art would have been motivated to add the remove key in order to allow users to change their minds and order different items.

Claims 11 and 25 require the transportable computer to calculate a total price of items in said order file and displaying the total price to the user.

968 teaches in the Abstract (step j) calculating an order total and displaying an order total screen on the display. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Handheld HQ to calculate an order total

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and display that total to the user as taught by 968 in order for a user to know exactly how much they are going to have to pay for their order.

Claims 15 and 41 require the displaying a message to the customer indication that order has been accepted. Examiner notes that 968's teaching of displaying an order total corresponds to a message indication the order has been accepted. In addition, Examiner references Figure 10, in which the message "Please Pull Forward" is associated with the display of the total. Examiner notes, this message clearly indicates to the customer that their order has been accepted.

As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Handheld HQ to include a message from the order terminal indicating to the customer that the order has been accepted as taught by 968, in order for the customer to be assured his/her order was received and is being processed.

Claims 10, 26, 51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handheld HQ in view of U.S. Patent Number 6,208,976 to Kinebuchi et al. (hereinafter Kinebuchi).

Handheld HQ, described in detail above teaches a user uploading a menu at a restaurant or online (Potential Applications 1 and 16). Handheld HQ does not teach receiving a menu update instruction after transmitting an order file to receiving terminal. Kinebuchi teaches an order management system with automatic menu updating. In particular the order management system transmits data to the terminal devices at start up. In this case Examiner notes that the start up described in Kinebuchi is the same as the upload process of Handheld HQ, as this is the "start" of the process. In addition, Examiner notes once again that Handheld HQ teaches a bi-

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directional communication system, where the order terminal not only receives the order but is capable of transmitting data.

As such it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Handheld HQ to include the order terminal transmitting data to the terminal device after uploading the order file in order to provide the user with the most current menu.

### *Conclusion*

Examiner thanks Applicant for the response to the request for information.

Examiner notes that a conversation between the Examiner and Ronald Kliot, the inventor of the Handheld HQ was held. Mr. Kliot stated the no updates or modifications were made to the system between 12/31/00 and 5/25/01 the date at which the information was officially posted to ip.com. Examiner requested documented proof of this and Mr. Kliot expressed that he would be able to provide this evidence. Examiner has several phone calls and e-mails in to Mr. Kliot waiting for the specific evidence.

In order to stick with the tenets of compact prosecution the Examiner has decided to submit this action, (as Non-Final) in order to work with the Applicant on the merits. Examiner notes that the only other path would include suspending prosecution for up to six (6) months.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

jak

*Michael Cuff* 12/20/04  
MICHAEL CUFF  
PRIMARY EXAMINER